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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SERGEY BRIN

Appeal 2009-000777
Application 09/843,923
Technology Center 2400

Before JOHN A. JEFFERY, LANCE LEONARD BARRY, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134(a) of the Examiner's non-final decision rejecting claims 18-41. Claims 1-17 are cancelled. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We Affirm-In-Part.

BACKGROUND

Appellant's invention relates generally to client/server networks. More particularly, the invention on appeal is directed to systems and methods that provide mechanisms for attracting users to a site on a network. (Spec. 1).

Claim 18 is illustrative:

18. A method for enticing users to access a web page, comprising:
 - modifying a standard company logo for a special event to create a special event logo;
 - associating one or more search terms with the special event logo, the one or more search terms relating to the special event;
 - uploading the special event logo to the web page;
 - receiving a user selection of the special event logo; and
 - invoking a search relating to the special event based on the one or more search terms in response to the user selection.

The Examiner relies on the following prior art references as evidence of unpatentability:

Wolff US 6,247,047 B1 Jun. 12, 2001

Yahoo! Main page, (1996), available at <http://web.archive.org/web/19961223150621/http://www8.yahoo.com/>

Appellant appeals the following rejections:

1. Claims 18, 19, 21-29, and 31-41 under 35 U.S.C. § 103(a) as unpatentable over Wolff and Yahoo.
2. Claims 20 and 30 under 35 U.S.C. § 103 as unpatentable over Wolff, Yahoo and Official Notice.

FACTUAL FINDINGS

We adopt the Examiner's findings in the Answer and Non-final Office Action as our own, except as to those findings that we expressly overturn or set aside in the Analysis that follows. Additional findings of fact may appear in the Analysis that follows.

1. Wolff teaches that after finding and retrieving a record, the host server sends a dynamically generated form page 108 over the Internet 16 for display. The page 108 is displayed by opening a new browser or new window on the user node 14. (Col. 9, ll. 9-15).
2. Wolff teaches a banner 102 that includes graphics relating to a particular product or service being advertised. (Col. 8, ll. 41-43; Fig. 2).

3. Wolff teaches that a URL and a unique indicia that identifies the product or service is embedded within banner 102. (Col. 8, ll. 43-49; Fig. 2).
4. Wolff teaches that the host server 12 receives the unique indicia embedded within banner 102 and “uses the indicia to search the on-line product/service database for a record containing information specific to the advertised product or service.” (Col. 9, ll. 4-7).

ISSUES

We decide the issues raised by Appellant *seriatim* in the Analysis below.

ANALYSIS

Claims 18, 19, 21, 23-25, 34²

Issue 1: Did the Examiner err in finding that the cited combination of references would have taught or suggested associating one or more search terms with a special event logo that was created by modifying a standard company logo for a special event, where the one or more search terms relate to the special event, within the meaning of representative claim 18? (App. Br. 7).

Appellant asserts that “Yahoo does not disclose or remotely suggest . . . ‘associating one or more search terms with the special event logo, let

² Based on Appellant’s arguments in the Appeal Brief (*7 et seq.*), we decide the appeal of claims 18, 19, 21, 23-25, and 34 on the basis of representative claim 18. See 37 C.F.R. § 41.37(c)(1)(vii).

alone one or more search terms that relate to the special event, as required by claim 18'.” (App. Br. 8-9). However, we note that the Examiner relied on Wolff to disclose the association of search terms with a logo, as claimed. (Ans. 3, 18). The Examiner relied on Yahoo for teaching “a special event logo.” (Ans. 3).

Wolff teaches a banner 102 that includes graphics relating to a particular product or service being advertised (FF 2), where a URL and a unique indicia that identifies the product or service is embedded within banner 102 (FF 3). Regarding the search limitation, Wolff teaches that host server 12 receives the unique indicia embedded within banner 102 and “uses the indicia to search the on-line product/service database for a record containing information specific to the advertised product or service.” (FF 4) (Emphasis added).

As pointed out by the Examiner, we agree that Yahoo teaches a special event logo. (Ans. 4). Because the Examiner’s rejection is based on the combined teachings of Wolff and Yahoo, we do not find persuasive Appellant’s arguments attacking each reference in isolation regarding *Issue 1.*

Issue 2: Did the Examiner err by improperly combining the cited references under § 103?

Appellant contends that Wolff “teaches away” from associating one or more search terms with static banners because the static banners involve only one-way communication and do not take advantage of Interactive capabilities. (App. Br. 9). However, we find this argument unconvincing because the portion of Wolff noted by Appellant does not discourage or

disavow associating one or more search terms with static banners *even if arguendo* the static banners involve one-way communication.³ (See Wolff col. 2, ll. 30-35)

Appellant further contends that the Examiner provided no motivation for modifying Wolff's advertisement banner with the prior art seasonal or one-time use static banner. (App. Br. 13). Appellant asserts that replacing Wolff's advertisement banner with the prior art seasonal or one-time use static banner would be directly contrary to the whole purpose of Wolff's system which provides information regarding an advertised product or service in response to a selection of a banner advertisement relating to the product or service. (*Id.*).

We disagree. As pointed out by the Examiner, we agree that the Yahoo logo is *altered* to commemorate the Christmas holiday. (Ans. 18; Yahoo 1). We also agree with the Examiner's findings that Yahoo evidences that it was well known in the art to modify an existing logo to one associated with a special event. (Ans. 4; Yahoo 1). We further agree with the Examiner that it would have been obvious to an artisan that the search terms would relate to what is being displayed by the image in some manner. (*Id.*).

³ "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006) (citations and internal quotation marks omitted). See also *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004) (noting that merely disclosing more than one alternative does not teach away from any of these alternatives if the disclosure does not criticize, discredit, or otherwise discourage the alternatives).

Moreover, we are of the view that Appellant's purported improvement over the prior art represents no more than the predictable use of prior art elements according to their established functions, and thus would have been obvious to one of ordinary skill in the art. *See KSR Int'l Co. v. Teleflex Inc.* 550 U.S. 398, 417 (2007) ("when a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious.") (citing *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976)).

Based on the record before us, we find the Examiner did not err in rejecting representative claim 18. Accordingly, we sustain the Examiner's § 103 rejection of independent claim 18, as well as claims 19, 21, 23-25, and 34 which fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Claims 28 and 36

Regarding independent claim 28 and dependent claim 36, Appellant's arguments are based on essentially the same grounds as previously submitted for independent claim 18. (App. Br. 24-25). Therefore, we sustain the Examiner's § 103 rejection of claims 28 and 36 for the same reasons discussed *supra* regarding claim 18.

Dependent Claims 40 and 41

Issue 3: Did the Examiner err in finding that the cited references would have taught or suggested searching the Internet, as recited in claim 40, or invoking a search for web pages related to a special event, as recited in claim 41?

Appellant contends that just because Wolff discloses a product/service database available over the Internet does not mean that searching the database is equivalent to searching the Internet. (App. Br. 15). We observe that Appellant essentially restates this same argument regarding claim 41. (App. Br. 24-25).

Based upon our review of the record, we agree with the Examiner's findings regarding claims 40 and 41. (Ans. 16, 19, and 20). We agree that an "Internet" search (claim 40) is a search of databases or other resources connected to the Internet, as evidenced by the Internet search box in the Yahoo reference. Moreover, we find that Wolff discloses the use of the Internet to complete product/service searches and requests. (FF 1). As discussed above, the Examiner relies on Yahoo for teaching "a special event logo." (Ans. 3). Thus, we find Yahoo at least suggests invoking a search for web pages related to a special event, within the meaning of claim 41. On this record, we find that the Examiner did not err in rejecting claims 40 and 41. Accordingly, we affirm the Examiner's § 103 rejection of claims 40 and 41.

Independent Claim 26

Issue 4: Did the Examiner err in finding that the cited references would have taught or suggested "*instructions* for uploading a special event logo to a web page." (Emphasis added).⁴ Appellant contends that the modified Yahoo logo is merely an end product and does not serve to teach or

⁴ Appellant's arguments regarding the limitations of claim 26 that were previously discussed regarding claim 18 are applicable here and will not be repeated.

suggest instructions for uploading the special event logo to the web page. (Reply Br. 5-6).

However, on this record, we agree with the Examiner's finding (which Appellant has not rebutted) that a logo that is viewable on a webpage must have been uploaded via computer instructions. (Ans. 7, 20-21). Moreover, we will not endeavor to read the word "automated" into the claim language as argued by Appellant on page 5 of the Reply Brief.

On this record, we find the Examiner did not err in rejecting independent claim 26. Accordingly, we affirm the Examiner's rejection of claim 26.

Dependent claim 29

Issue 5: Did the Examiner err in finding that the cited references would have taught or suggested instructions for modifying the standard logo with one or more animated images, as recited in dependent claim 29? (App. Br. 17).

Based upon our review of the record, we agree with Appellant that the Examiner has not established that instructions for modifying the standard logo with one or more animated images is fairly taught or suggested by the cited combination of references. (App. Br. 18). In particular, we see no "animated" image in the evidence before us. Therefore, we reverse the Examiner's § 103 rejection of claim 29.

Dependent Claims 31 and 35

Issue 6: Did the Examiner err in finding that the cited references would have taught or suggested instructions for modifying the standard

company logo with information associated with a holiday, as recited in dependent claim 31. Appellant contends that the Examiner has not provided any evidence that the Yahoo logo “was modified by *executing* instructions for modifying a standard company logo with information associated with a holiday, as required by claim 31.” (App. Br. 18) (Emphasis added).

However, we observe that claim 31 does not recite “executing” instructions. Instead, claim 31 is directed to instructions that are stored on a medium that could be executed, but are not positively recited as actually being executed. See the preamble of claim 26, from which claim 31 depends. Therefore, we sustain the Examiner’s rejection of claim 31 because Appellant argues limitations that are not expressly claimed. (Ans. 22). Because Appellant relies on the same “executing instructions” argument regarding the rejection of claim 35 (“executing instructions” are not recited in claim 35), we likewise sustain the Examiner’s rejection of claim 35. (*See* App. Br. 19).

Independent Claim 27

Issue 7: Did the Examiner err in finding that the cited references would have taught or suggested a processor configured to determine a home page of a web page on a network, or identifying a standard company logo, as recited in representative claim 27?

Appellant contends that the Examiner’s findings have no support in either the Wolff or Yahoo references. (App. Br. 20 *et. seq.*). According to Appellant, the mere fact that Yahoo shows a modified Yahoo logo in no way means that a processor executed instructions to determine the home page or identify a standard company logo for the Yahoo web site. (App. Br. 21-22).

The Examiner contends that Wolff teaches the *inherent* use of a computer processor. (Ans. 23). The inherent features of Wolff are not contested by Appellant. Further, we agree with the Examiner that Yahoo teaches an uploaded image that is an altered version of the company logo on a home page (www.yahoo.com). (Ans. 23). Therefore, we find the cited combination of references strongly suggestive of a processor that executes instructions to determine (i.e., display) a home page on a network, and also instructions to identify a standard company logo by virtue of displaying the home page. Because we find the weight of the evidence supports the Examiner's position, we affirm the Examiner's § 103 rejection of independent claim 27.

Claims 32 and 33

Regarding dependent claims 32 and 33, Appellant's arguments are based on essentially the same grounds as previously submitted for independent claims 18 and 27. (App. Br. 23). Therefore, we sustain the Examiner's § 103 rejection of claims 32 and 33 for the same reasons discussed *supra* regarding independent claims 18 and 27.

Claims 37-39

Regarding claims 37-39, Appellant's arguments are based on essentially the same grounds as previously submitted for independent claims 18 and 41. (App. Br. 26). Therefore, we sustain the Examiner's § 103 rejection of claims 37-39 for the same reasons discussed *supra* regarding claims 18 and 41.

Dependent Claim 22

Regarding claim 22, Appellant's arguments are based on the same grounds as previously submitted for independent claims 18 and 37. (App. Br. 26). Therefore, we sustain the Examiner's § 103 rejection of claim 22 for the same reasons discussed *supra* regarding independent claims 18 and 37.

Dependent Claims 20 and 30 (2nd § 103 rejection)

Issue 8: Did the Examiner err in finding that the cited references would have taught or suggested modifying the standard company logo with at least one of video or audio, as recited in dependent claim 20 and instructions for modifying the standard company logo with at least one of video or audio, as recited in dependent claim 30.

Regarding the Examiner's reliance on "Official Notice," Appellant contends that the Examiner has merely stated a conclusion without providing any evidence or reasoned explanation as support. (App. Br. 27-28).

Regarding the Examiner's taking of "Official Notice" that it was well known to use video or audio data to modify a web page, we find no statement in Appellant's Briefs that it was *not well known* to use video or audio data to modify a web page. Instead, Appellant merely states that the Examiner has not provided evidence. (App. Br. 27-28). Thus, we find Appellant has not made an express *demand* for evidence from the Examiner, as required to challenge the Examiner's finding. (*See* MPEP § 2144.03). We note that to adequately traverse the Examiner's finding, Appellant must specifically point out the supposed errors in the Examiner's action, *which would include stating why the noticed fact is not considered to be common*

knowledge or well-known in the art. See 37 C.F.R. 1.111(b). See also MPEP § 2144.03. Accordingly, because Appellant has not met the requisite burden, we sustain the Examiner's rejection of claims 20 and 30 as being obvious over the combination of Wolff, Yahoo, and "Official Notice."

DECISION

We reverse the Examiner's § 103 rejection of claim 29.

We affirm the Examiner's § 103 rejections of claims 18-28 and 30-41.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See 37 C.F.R. § 1.136(a)(1)(iv) (2009).*

AFFIRMED-IN-PART

rwk

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